

## **REMARKS**

### **Status of the Claims**

Claims 1 and 3-27 are pending in this application.

Claims 1 and 3-27 are rejected.

Claims 1 is objected to.

Claims 1 and 18 have been amended. Support for these amendments can be found throughout the specification, claims, and drawings, as originally filed.

### **Rejection of Claims 19-20 Under 35 U.S.C. § 112**

Claims 19-20 were rejected under 35 U.S.C § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action indicated that "[a]pplicant recites that in Claim 18, of which claims 19-20 are dependent upon, the annular reflector being located behind the light-conducting element in beam direction, which contrasts the limitations found in claims 19-20 with respect to the light being transferred from the annular reflector to the light conducting element. Therefore, the claimed apparatus could not be distinguished with respect to which component the light beam strikes first and remains indefinite in structure..." Applicants now respectfully traverse the rejection of claims 19-20. Applicant has amended claim 18 to recite in pertinent part "...light emitted from an LED in front of said light conducting element passes through said light conducting element in contacts said annular reflector, and light emitted from an LED positioned between said annular reflector and behind said light conducting element, contacts said annular reflector." Applicants assert that the amendment made to claim 18 now resolves any issues of indefiniteness with regard to claims 19-20. Claim 18 now

clearly discloses which components are contacted with the beam of light first. Applicant respectfully request removal of the rejection of claims 19-20.

### **Rejection of Claims 1-23 Under 35 U.S.C. § 102(b)**

Claims 1-23 of the present application were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,447,155, issued to Kondo, et al. (hereafter Kondo). With respect to claim 1, the Office Action indicated that Kondo disclosed a lamp for a motor vehicle that included “[a] housing [Figure 1: (1)] in which at least one light source [Figure 2: (11, 21)] is arranged, wherein said at least one light source is an LED [Figure 2: (11)]; and at least one reflection part [Figure 2: (12, 22)] associated with the light source, wherein at least one reflection part [Figure 2: (12)] is adjacent to and surrounds the LED and has a height [Figure 2: (14a, 14c)] that is less than or equal to the LED.” Applicants respectfully traverse the 35 U.S.C. § 102(b) rejection of claim 1. The § 102 rejection of claim 1 fails on several points. First the present Office Action does not appear to maintain or overcome Applicants’ previous arguments regarding inherency. Second the § 102 rejection improperly relies upon an obviousness argument. Lastly Claim 1 as amended is no longer anticipated.

The present Office Action does not anticipate the portion of claim 1 that states “...an LED emitting light laterally from said LED...” Applicants note that the previous Office Action dated December 23, 2004 did assert that this particular claim feature was inherent to claim 1. However, Applicants response mailed January 24, 2005 traversed the inherency argument stating that “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957

(Fed. Cir. 1993); MPEP 2112 at p. 2100-52. In order to establish inherency, extrinsic evidence must make it clear that the missing descriptive matter that is not present in a reference would be recognized by persons of ordinary skill. *In re Roberertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999); See also MPEP 2112 at 2100-52. It has further been stated that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support this determination that allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Intr. 1990). Applicants note that the § 102 rejection of claim 1 is completely silent with respect to the portion of claim 1 that states "...an LED emitting light laterally from said LED...". Additionally this particular feature is not inherent since the September 23, 2004 Office Action failed to provide adequate support for the inherency argument. Applicants still maintain this argument. Thus each and every element of claim 1 is still not anticipated by Kondo.

The present § 102(b) rejection impermissibly relied upon obviousness when it stated that "[t]he Examiner makes further note that it would also be an obvious matter of design choice to change the size of the reflection part to effect the illumination at a desired preference, since a modification would have involved a mere change in the size of a component". According to the Federal Circuit "[a]nticipation requires the disclosure of a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. Z Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (*citing Soundsciber Corp. v. United States*, 360 F. 2d 954, 1950, 148 USPQ 298, 301 (Ct. Co.)) [emphasis added]. The present office action relied on obviousness to anticipate the portion of claim 1 which states that "...said LED has a height that is less

than or equal to said LED.” There is nothing in the Office Action that points to where in Kondo this particular feature is disclosed, therefore, Kondo by itself does not anticipate claim 1 because a single reference must disclose each element of claim 1. Arguing obviousness here goes against the fundamentals of 35 USC § 102. See *W.L. Gore & Assocs. Z Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore Applicants request removal of the 35 USC § 102(b) rejection of claim 1.

Applicants further note that claim 1 as amended is no longer anticipated by the Kondo patent. More specifically claim 1 has been amended to state in pertinent part “...wherein said at least one reflection part adjoins and surrounds said LED in the same plane...” Applicants have amended claim 1 to remove the language that describes the reflection part as being adjacent and has added language indicating that the reflection part adjoins the LED. Kondo fails to anticipate this portion of claim because the reflection part of Kondo does not adjoin the LED. Applicants further note that claim 1 has been amended to add the language indicating that the reflection part surrounds the LED in the same plane. Applicants point out that Kondo fails to anticipate this portion of claim 1 because Fig. 2 of Kondo shows a reflection part that is positioned away and does not adjoin nor does it surround the LED in the same plane.

For all the above reasons Applicants maintain that the Kondo patent does not anticipate each and every element of claim 1; therefore, Applicants respectfully requests removal of the 35 U.S.C. § 102(b) rejection of claim 1 and allowance thereof. Additionally, claims 3-27 are all dependent claims that either depend directly or indirectly from independent claim 1. These claims are not anticipated by Kondo by virtue of their dependency upon claim 1. As such Applicants respectfully request removal of the rejection of claims 3-27 and allowance thereof.

### **Rejection of Claims 24-27 Under 35 U.S.C. § 103(a)**

The Office Action indicated that claims 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,447,155 issued to Kondo et al. (hereafter Kondo) as applied to claim 1 above and further in view of U.S. Patent No. 5,136,483 to Schöniger et al. (hereafter Schöniger). Claims 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo as a single reference. Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 24-27. Applicants submit that Kondo fails with respect to claim 1 for the reasons indicated in the 102 section immediately above. Applicants hereby assert that the same arguments made with regard to the § 102 rejection will apply here because claims 24-27 are all ultimately dependent from claim 1. Applicants will now address the patentability of claim 1 and dependent claims 24-27 in view of the proposed combination of references. Applicants will also address the obviousness argument presented in the § 102 rejection.

With regard to rejection of claim 24-27 Applicants respectfully traverse the rejection submitting that the proposed combination of references do not render obvious claims 24-27. Applicants point out that claims 24-27 depend from independent claim 1 which is not rendered obvious by the combination of Kondo in view of Schöniger. The combination of references fail to render claim 1 obvious in at least three distinct ways. First the portion of claim 1 that states "...an LED emitting laterally from said LED..." Applicants note that the present Office Action does not explain where this particular feature is taught or suggested by the combination of Kondo in view of Schöniger. Second the Office Action stated with respect to claim 1 that "[t]he Examiner makes further note that it would also be an obvious matter design choice to change the size of

the reflection part to affect illumination at a desired preference since a modification would have involved a mere change in the size of a component.” Applicants note that the Office Action does not point out where the Kondo reference teaches or suggests changing the size of the reflector, nor did Applicants see this in the Kondo patent. Therefore, this particular feature would not be rendered obvious by Kondo without any supporting evidence. Lastly Applicants note that claim 1 as currently amended is not rendered obvious by the Kondo reference claim 1 in pertinent part has been amended to state “...wherein said at least one reflection part adjoins and surrounds said LED in the same plane...” Kondo describes a double-stacked type lamp unit having an LED lamp and an incandescent lamp. See Kondo Col. 1, Lines 55-66. The reflecting surface in Kondo is located outside of the plane of the LED and does not adjoin the LED. See Kondo Fig. 1, Col. 2, Lines 50-63. For these reasons Applicants maintain that Kondo does not teach or suggest all the elements of claim 1. Applicants further note that the Schöniger reference when used in combination with Kondo does not fill the gaps left by Kondo.

In order for the combination of Kondo in view of Schöniger to render claim 1, and ultimately dependent claims 24-27 obvious the deficiencies of Kondo discussed above must be taught or suggested by the Schöniger reference. Applicants point out that the Schöniger reference is directed to a generally flat transparent illuminating element with a circumferential edge having a plurality of light emitting elements set in the edge. There is nothing in the specification of the Schöniger reference that teaches or suggests the LED emitting light laterally, or the reflection part adjoining and surrounding the LED in the same plane. Schöniger also does not teach or suggest the size of the reflector being a height that is less than or equal to the LED. As such Applicants respectfully request the removal of the 35 U.S.C. § 103 rejection of claims 24-27 since these claims

are dependent upon independent claim 1 which is clearly not rendered obvious by Kondo in view of Schöniger.

### **CONCLUSION**

It is respectfully submitted that in view of the above amendments and remarks the claims 1 and 3-27, as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicants submit that the pending claims are properly allowable, which allowance is respectfully requested.

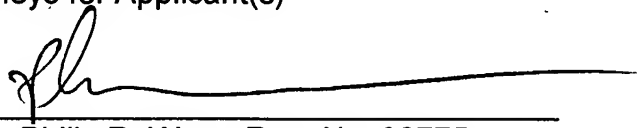
The Examiner is invited to telephone the Applicants' undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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